

## Remarks

### Status of the Claims

The Office indicated that all Claims were allowable over the art. The Office asserted a provisional obviousness-type double patenting rejection based on copending application 10/342,578. The Office made the rejection final.

### Provisional Double-patenting Rejection as a Final Rejection

As discussed below, Applicant submits that there is not a *prima facie* case to support the obviousness-type rejection asserted by the Office. However, even the rejection is correct, Applicant respectfully submits that a final action in which the sole rejection is a **newly-asserted, provisional** obviousness-type double patenting rejection is not proper. See MPEP 804.I.B. ("If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent ..."). Applicant respectfully requests that the provisional rejection be withdrawn and that the present application be permitted to issue as set forth in MPEP 804.I.B.

Further, a provisional rejection is allowed to allow the merits of such rejection to be addressed without waiting for the first patent to issue. See MPEP 804.I.B. In the present application, the provisional rejection was **first** asserted relative to claims 1-21, 23-38, and 39-40 in the **final** action. Making a **new** rejection in a **final** action does not allow the merits of the double patenting rejection to be addressed. If the provisional rejection is not withdrawn, Applicant respectfully requests that the finality of the present action be withdrawn so that the merits of the provisional rejection can be addressed.

### Merits of the Double-patenting Rejection

For an actual double-patenting rejection, the claims must be examined to determine whether they are an obvious variation of the claims in the issued patent. See MPEP 804.II.B; *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*, 56 USPQ2d 1434, 1435-36 (Bd. Pat. App. & Inter. 2000). The analysis is similar to that for 35 U.S.C. 103, except that the only the claims (not the disclosure) of the issued patent are considered. See MPEP 804.II.B; *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967); *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Note that in the present application there is no issued patent, and hence no actual double patenting rejection. Nonetheless, in the interests of expeditious prosecution, Applicant addresses the merits of the rejection.

The Office asserted a provisional double patenting rejection of Claims 1-19 based on an assertion that Claims 1-20 and 21-30 of the '578 application were narrower in scope than Claims 1-19 of the present application. Applicant notes that Claims 1-30 have been cancelled from the '578 application, and that this provisional rejection is accordingly moot. Applicant submits that Claims 1-19 of the present application are ready for issuance.

The Office asserted provisional double patenting rejections of Claims 20-40 based on similar assertions relating to Claims 31-40 of the '578 application. Applicant respectfully traverses the Office's assertion. For a *prima facie* case of obviousness, the reference (in a double patenting rejection the claims of the issue patent) must teach or suggest all the limitations of the claims. See MPEP 2142. The claims of the '578 application do not teach or suggest all the limitations of Claims 20-40, and accordingly there is no *prima facie* case of obviousness to support a double patenting rejection.

Claims 31-40 of the '578 application all concern methods of aligning optical paths in an interferometer. The methods claimed are applicable to various interferometer designs, and the Claims do not recite any specific interferometer design. In contrast, Claims 20-40 concern specific interferometer designs, including specific relationships among beam splitters, reflective elements, and OPD elements. Since the claims of the '579 application do not include any such limitations,

there is no *prima facie* case of obviousness of Claims 20-40. Claims 22 and 39 include addition of a corrective element to the specific interferometer design of their respective parent claims. Since the claims of the '578 application do not teach or suggest all the limitations of the parent claims, they can not teach or suggest all the limitations of the dependent claims. Applicant submits that Claims 20-40 are ready for issuance.

**Conclusion**

Applicant has responded to each and every rejection and urges that the Claims as presented are in condition for allowance. Applicant requests expeditious processing to issuance.